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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
	10/593,988	SCHRAMM, PETER
Office Action Summary	Examiner	Art Unit
	CARLOS GAMINO	1793
The MAILING DATE of this communication app Period for Reply	ears on the cover sheet with the c	orrespondence address
A SHORTENED STATUTORY PERIOD FOR REPLY WHICHEVER IS LONGER, FROM THE MAILING DA - Extensions of time may be available under the provisions of 37 CFR 1.13 after SIX (6) MONTHS from the mailing date of this communication. - If NO period for reply is specified above, the maximum statutory period w - Failure to reply within the set or extended period for reply will, by statute, Any reply received by the Office later than three months after the mailing earned patent term adjustment. See 37 CFR 1.704(b).	ATE OF THIS COMMUNICATION 36(a). In no event, however, may a reply be tim vill apply and will expire SIX (6) MONTHS from cause the application to become ABANDONE	N. nely filed the mailing date of this communication. D (35 U.S.C. § 133).
Status		
Responsive to communication(s) filed on <u>03 Ju</u> This action is FINAL . 2b)☑ This Since this application is in condition for allowar closed in accordance with the practice under E	action is non-final. nce except for formal matters, pro	
Disposition of Claims		
4) Claim(s) 11-35 is/are pending in the application 4a) Of the above claim(s) 24-29 is/are withdraw 5) Claim(s) is/are allowed. 6) Claim(s) 11-23 and 30-35 is/are rejected. 7) Claim(s) is/are objected to. 8) Claim(s) are subject to restriction and/or Application Papers 9) The specification is objected to by the Examine 10) The drawing(s) filed on 9/25/06 is/are: a) acc	n from consideration. relection requirement. r. cepted or b) □ objected to by the	
Applicant may not request that any objection to the c Replacement drawing sheet(s) including the correcti	on is required if the drawing(s) is obj	ected to. See 37 CFR 1.121(d).
11)☐ The oath or declaration is objected to by the Ex	aminer. Note the attached Office	Action or form PTO-152.
Priority under 35 U.S.C. § 119		
 12) Acknowledgment is made of a claim for foreign a) All b) Some * c) None of: 1. Certified copies of the priority documents 2. Certified copies of the priority documents 3. Copies of the certified copies of the prior application from the International Bureau * See the attached detailed Office action for a list of the certified copies of the prior 	s have been received. s have been received in Applicati ity documents have been receive ı (PCT Rule 17.2(a)).	on No ed in this National Stage
Attachment(s) 1) Notice of References Cited (PTO-892) 2) Notice of Draftsperson's Patent Drawing Review (PTO-948) 3) Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date 9/25/06.	4) Interview Summary Paper No(s)/Mail Da 5) Notice of Informal P 6) Other:	nte

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DETAILED ACTION

Election/Restrictions

1. Applicant's election of Species aA and bE, claims 11-13, 15-23 and 30-35 in the reply filed on 6/3/09 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)). The examiner notes that claim 14 was not elected even though it contains the elected Species aA. For the purpose of this examination claim 14 will be examined but limited to adhesive only.

Specification

2. The disclosure is objected to because of the following informalities: reference numeral 4 is referred to both as a tip and pin in paragraph 0011 and "usefully" in paragraph 0012 is awkward.

Appropriate correction is required.

Claim Objections

- 3. **Claim 11** is objected to because of the following informalities: "in said bold existing" should be –in said bolt existing—. Appropriate correction is required.
- 4. **Claim 11 is** objected to because of the following informalities: where a claim sets forth a plurality of elements or steps, each element or step of the claim should be separated by a line indentation, 37 CFR 1.75(i). Appropriate correction is required.

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Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

- 6. Claim 18 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite
- for failing to particularly point out and distinctly claim the subject matter which applicant

regards as the invention.

7. Claim 18 recites the limitations "said exterior surface" and " the substantially

conical takeout angle ". There is insufficient antecedent basis for this limitation in the

claim.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
- 9. Claims 11-13, 14-16, 22-23, 30-32 and 34-35 are rejected under 35
- U.S.C. 102(b) as being anticipated by Rufin et al. (US 4,975,014).

Regarding claim 11, Rufin discloses:

A receiving element, comprising

a bolt having an exterior surface that is substantially parallel to a longitudinal axis of the bolt and that can be introduced into a bore in at least one component [pin (12); refer to figures 1 and 2 for all reference numbers],

said bolt including or containing wear-resistant sintered material [pin (12) can be made from alumina oxide, monolithic ceramics or other ceramic matrix composites; column 3, lines 63-65] and including a recess [inset portion (23)] at a forward end thereof; and

a tip comprised of metal arranged at the forward end of said bolt [inserts (13) are made of metal and arranged at the forward end of the pin; column 4, lines 41-44],

the tip including an end section [inner surface (28)] which engages in said recess [insert portion (23)] of said bolt,

a direct connection between said end section of said tip and said recess in said bolt existing in a connecting area provided at the forward end of said bolt which extends only over a portion of an entire length of said bolt [the insert portion only extends over a portion of the entire pin and it makes a direct connection to the inner surface],

said tip further including a forward section [extended portion (32)] which projects axially out of said bolt,

a transition area being interposed between the forward section [extended portion (32)] of said tip and the forward end of said bolt [the tapered section of the shank (20) is a transition area; best seen in figure 2],

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said transition area tapering to said forward section of the tip in a manner such that the receiving element has a stepped exterior contour [the tapered section mentioned above tapers towards the tip and forms a stepped exterior contour],

said forward section having a maximum external diameter [this being the diameter of the threads pointed to by (31)] that is less than a corresponding exterior diameter of said bolt [this being the diameter of the head (19)] by a prescribed amount.

Concerning the underlined phrases in the claims, above and below; these limitations are intended use, functional language or material worked upon and do not further limit the apparatus structurally. Therefore, it is the examiner's position that the (collective) apparatus of the prior art is capable of performing the claimed function(s) with the claimed material (MPEP 2111.02, 2114, 2115).

Regarding claim 12, Rufin discloses:

wherein said exterior surface is coaxial with said axis [the exterior surface of pin (12) is coaxial with its axis].

Regarding claim 13, Rufin discloses:

wherein said at least one component includes at least two components.

Regarding claim 15, Rufin discloses:

wherein said end section [inner surface (28)] which engages in said recess has an external diameter that is smaller by a prescribed amount than the maximum external diameter of said forward section [extended portion (32)] [inner surface is an external curved surface therefore it has an external diameter and the extended portion has a

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curved surface opposite the inner surface therefore it has a larger maximum external diameter].

Regarding claim 16, Rufin discloses:

wherein a step [distal facing surface (29)] is provided between said forward section and said end section of said tip that defines an axial stop with respect to said bolt.

Regarding claim 22, Rufin discloses:

wherein said bolt includes a fastening body [head (19)] that is an integral component of said bolt and that comprises a same material as said bolt, said fastening body being disposed at an other end said bolt opposite to said forward end.

Regarding claim 23, Rufin discloses:

wherein said fastening body includes a flange [head (19) is a flange] having an external flange diameter which is larger than said external diameter of said bolt.

Regarding claim 30, Rufin discloses:

wherein said wear-resistant sintered materials comprise oxide ceramics or nonoxide ceramics [alumina oxide; column 3, line 59].

Regarding claim 31, Rufin discloses:

said ceramics include Al_2O_3 [alumina oxide; column 3, line 59], ZrO_2 , or Si_3N_4 , or mixtures thereof.

Regarding claim 32, Rufin discloses:

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wherein said portion of the entire length of said bolt extends over less than 50% of said entire length [figure 2 clearly chows that the length of the surfaces in contact between the pin and end section is less than 50% of the entire length of the pin].

Regarding claim 34, Rufin discloses:

wherein said receiving element is configured for use in welding equipment.

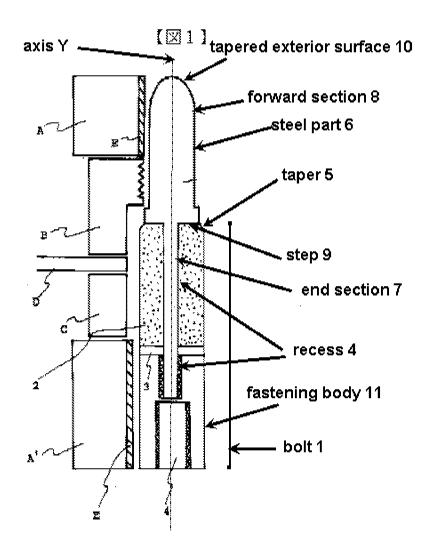
Regarding claim 35, Rufin discloses:

wherein said welding equipment includes a pressure welding tool.

10. Claims 11-13, 15-19, 22, 30-31 and 34-35 are rejected under 35 U.S.C. 102(b) as being anticipated by Takuma et al. (JP 6-226458).

Regarding claim 11, Takuma discloses:

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A <u>receiving</u> element, comprising

a bolt [bolt 1; for all reference numbers refer to the above figure] having an exterior surface that is substantially parallel to a longitudinal axis of the bolt and that can be introduced into a bore in at least one component,

said bolt including or containing wear-resistant sintered material [ceramic part (2) can be made from sintered silicon nitride, alumina, etc.; abstract and paragraph 0005] and including a recess [recess (4)] at a forward end thereof; and

a tip [steel part (6); abstract] comprised of metal arranged at the forward end of said bolt,

the tip including an end section [end section (7)] which engages in said recess of said bolt,

a direct connection between said end section of said tip and said recess in said bolt existing in a connecting area provided at the forward end of said bolt which extends only over a portion of an entire length of said bolt [the above figure shows that the end section is in direct connection with the recess],

said tip further including a forward section [forward section (8)] which projects axially out of said bolt,

a transition area [taper (5)] being interposed between the forward section of said tip and the forward end of said bolt,

said transition area tapering to said forward section of the tip in a manner such that the receiving element has a stepped exterior contour [taper (5) tapers towards the tip and forms a stepped exterior contour],

said forward section having a maximum external diameter that is less than a corresponding exterior diameter of said bolt by a prescribed amount [the diameter of forward section (8) is less than that of the bolt (1) by a prescribed amount; also see paragraph 0007].

Concerning the underlined phrases in the claims, above and below; these limitations are intended use, functional language or material worked upon and do not further limit the apparatus structurally. Therefore, it is the examiner's position that the

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(collective) apparatus of the prior art is capable of performing the claimed function(s) with the claimed material (MPEP 2111.02, 2114, 2115).

Regarding claim 12, Takuma discloses:

wherein said exterior surface is coaxial with said axis [the exterior surface of bolt (1) is coaxial with its axis].

Regarding claim 13, Takuma discloses:

wherein said at least one component includes at least two components.

Regarding claim 15, Takuma discloses:

wherein said end section which engages in said recess has an external diameter that is smaller by a prescribed amount than the maximum external diameter of said forward section [the diameter of the end section is less than that of the forward section].

Regarding claim 16, Takuma discloses:

wherein a step [step (9)] is provided between said forward section and said end section of said tip that defines an axial stop with respect to said bolt.

Regarding claim 17, Takuma discloses:

wherein said forward section has an exterior surface [tapered exterior surface (10)] that tapers substantially conically toward a free end with a prescribed takeout angle.

Regarding claim 18, Takuma discloses:

wherein said exterior surface of said transition area has a transition takeout angle that is substantially greater than the substantially conical takeout angle of said forward section [the angle of taper (5) is at some point is greater than that of surface (10)].

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Regarding claim 19, Takuma discloses:

wherein said exterior diameter of said bolt is in a range of 3 to 12 mm [11mm; paragraph 0007].

Regarding claim 22, Takuma discloses:

wherein said bolt includes a fastening body [fastening body (11)] that is an integral component of said bolt and that comprises a same material as said bolt, said fastening body being disposed at an other end said bolt opposite to said forward end.

Regarding claim 30, Takuma discloses:

wherein said wear-resistant sintered materials comprise oxide ceramics or nonoxide ceramics [silicon nitride, alumina; paragraph 0005 and abstract].

Regarding claim 31, Takuma discloses:

said ceramics include Al Al_2O_3 , ZrO_2 , or Si_3N_4 , or mixtures thereof [silicon nitride, alumina; paragraph 0005 and abstract].

Regarding claim 34, Takuma discloses:

wherein said receiving element is configured for use in welding equipment.

Regarding claim 35, Takuma discloses:

wherein said welding equipment includes a pressure welding tool.

Claim Rejections - 35 USC § 103

- 11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:
 - (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

12. **Claim 14** is rejected under 35 U.S.C. 103(a) as being unpatentable over Takuma et al. (JP 6-226458) as applied to claim 11 above, and further in view of Nakamura et al. (JP 4-19032).

Takuma does not teach wherein said end section of said tip is joined in said recess to said bolt by at least one of an adhesive joint.

Nakamura teaches a reference pin. The pin has a steel head (2) and a ceramic, Al₂O₃, ZrO₂, or Si₃N₄, intermediate part (3) which is bonded to head (2) by adhesive (2c) to prevent slackening and generation of wear and/or chipping. The steel head fits into a recess in the ceramic body, has a second diameter that is larger then the diameter of the section that fits into the recess and does not extend the entire length of the pin.; figure 1, page 227 top left column, and abstract.

It would have been obvious to one of ordinary skill in the art at the time of the invention to use the adhesive method of Nakamura to bond the pin of Takuma in order to prevent slackening and generation of wear and/or chipping.

13. Claims 20-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takuma et al. (JP 6-226458) as applied to claim 19 above.

Takuma does not teach wherein said range is 3.5 to 10 mm or 4 to 8.5 mm.

However Takuma does teach that the diameter of the bolt is 11 mm as noted above.

It would have been obvious to one of ordinary skill in the art at the time of the invention that the size of the bolt would vary depending on the type and size of the

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materials involved, the manufacturing processes involved, and the end use of the product made. Therefore, choosing a size of a bolt is not an inventive step but merely a basic step in manufacturing.

Additionally, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233.

Also, In re Geisler 43 USPQ2d 1365 (Fed. Cir. 1997); In re Woodruff, 16 USPQ2d 1934 (CCPA 1976); In re Malagari, 182 USPQ 549, 553 (CCPA 1974) and MPEP 2144.05.

14. Claims 11-23 and 30-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over the collective teachings of Takuma et al. (JP 6-226458), Nakamura et al. (JP 4-19032) and Matsuzaki (JP 2-290696) in view of the collective teachings of DeBell et al. (US 5,248,869), Fukizawa (JP 11-291057) and Ichikawa (JP 5-277750).

Regarding claims 11, 22 and 23,

Takuma teaches a reference pin. The pin has a steel tip (6) and bolt (1) containing a sintered ceramic body (2) made of alumina or silicon nitride. The steel tip fits into recess (4) in the bolt (1) and has a second diameter that is larger then the diameter of the section that fits into the recess smaller than the exterior diameter of the body. The body includes ceramic because it prevents electrolytic corrosion, prevents spatter from sticking to the pin, and reduces wear and tear. The body also has a taper (5) that tapers towards the tip and an integral fastening body (11); above figure, abstract and paragraph 0005.

Nakamura teaches a reference pin. The pin has a steel head (2) and a ceramic, Al₂O₃, ZrO₂, or Si₃N₄, intermediate part (3) which is bonded to head (2) by adhesive (2c). The steel head fits into a recess in the ceramic body, has a second diameter that is larger then the diameter of the section that fits into the recess and does not extend the entire length of the pin. Base (4) appears to be a integral fastening body; figure 1, page 227 top left column, and abstract.

Matsuzaki teaches a positioning pin. The pin has a metallic introducing member (3) that does not extend the entire length of the pin and a sintered ceramic sleeve (2); figure 2. The member (3) fits into a recess in the ceramic body, has a second diameter that is larger then the diameter of the section that fits into the recess, and does not extend the entire length of the pin. Threads (5) are an integral fastening body; figure 2, page 633 top left column and abstract.

Collectively, Takuma, Nakamura and Matsuzaki (Takuma collective) teach that a center pin with a steel tip and ceramic body. The steel tip has two diameters, the smaller of the two fits into the recess of the ceramic body while the larger is large enough to rest on the ceramic body but smaller than the exterior diameter of the body and does not need to extend the entire length of the pin. The body also has an integral fastening element, a tapered section and is connected to the tip via the recess.

What the Takuma collective does not teach is a receiving element:

wherein said fastening body includes a flange having an external flange diameter which is larger than said external diameter of said bolt.

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DeBell teaches a locating pin. The pin has a ceramic base (12), which comprises neck portion (20), central opening (40), body portion (16) and flange (18), and a tip (14). (The examiner notes that this structure is identical to the claimed structure.) The base is made of ceramic for impact resistance reasons. Figures 3, 5 and 7 also show that the integral shaft (42) of the tip can vary in length; columns 5-6 and figure 7.

Fukizawa teaches a guide pin. The pin has a ceramic body partially force fit into metal member (2); abstract and figure 1.

Ichikawa teaches a guide pin. The pin has a body with a flange (2, 13) and tip (1) which is inserted into a partial recess in the base; abstract and figures 1-3 and 5.

Collectively, DeBell, Fukizawa and Ichikawa (DeBell collective) teach that a tip can be joined to base with a flange made entirely of the same material and the length of the bonding surface for the joining does not need to encompass the entire length of the base.

All of the limitations are taught by either the Takuma or DeBell collectives. The invention is now reduced to a matter of structure design, which pin best fits the application at hand. It would have been obvious to one of ordinary skill in the art at the time of the invention that the structure of the pin is limited by the apparatus being used, the materials being used and the process being used. One needing a steel tip and ceramic base/bolt would look to the Takuma collective and one wanting a base/bolt with a flange made entirely of the same material and having the tip only partially inserted into a recess in the base would look to the DeBell collective. Therefore, it would have been

obvious to one of ordinary skill in the art at the time of the invention that the teachings of the Takuma collective could be made into a structure taught by the DeBell collective in order to use the end product in an existing apparatus or process. Additionally, the claims would have been obvious because a particular technique, i.e. "the DeBell collective structure", was recognized as part of the ordinary capabilities of one skilled in the art. Accordingly, the claim would have been obvious because "a person of ordinary skill has good reason to pursue the known options within his or her technical grasp. If this leads to an anticipated success, it is likely the product not of invention but of ordinary skill and common sense." Thus, the claim would have been obvious because a person of ordinary skill in the art would have been motivated to combine the prior art to achieve the claimed invention and that there would have been a reasonable expectation of success and/or predictable results.

Regarding claim 12, the Takuma collective teaches:

wherein said exterior surface is coaxial with said axis [all of the references above show the exterior surface of the base/bolt coaxial with the axis of the pin].

Regarding claim 13, the Takuma collective teaches:

wherein said at least one component includes at least two components.

Regarding claim 14, the Takuma collective teaches:

wherein said end section of said tip is joined in said recess to said bolt by at least one of an adhesive joint.

Nakamura teaches the pin has a steel head (2) and a ceramic, Al₂O₃, ZrO₂, or Si₃N₄, intermediate part (3) which is bonded to head (2) by adhesive (2c) to prevent

slackening and generation of wear and/or chipping; figure 1, page 227 top left column, and abstract.

It would have been obvious to one of ordinary skill in the art at the time of the invention to use the adhesive method of Nakamura to bond the pin of the collectives in order to prevent slackening and generation of wear and/or chipping.

Regarding claim 15, the Takuma collective teaches:

wherein said end section which engages in said recess has an external diameter that is smaller by a prescribed amount than the maximum external diameter of said forward section [as noted above the Takuma collective teaches this].

Regarding claim 16, the Takuma collective teaches:

wherein a step is provided between said forward section and said end section of said tip that defines an axial stop with respect to said bolt.

As can been seen in all of the Takuma collective references a step is provided on the tips so that the tip rests on the bolt. Furthermore, DeBell and Ichikawa teach this. It would have been obvious to one of ordinary skill in the art at the time of the invention to use a step in order to prevent the tip from being pushed into the recess of the bolt too far.

Regarding claim 17, the Takuma collective teaches:

wherein said forward section has an exterior surface that tapers substantially conically toward a free end with a prescribed takeout angle.

All the references teach a tapered tip. It would have been obvious to one of ordinary skill in the art at the time of the invention to use a tapered tip in order to facilitate the placement of workpieces.

Regarding claim 18, the Takuma collective teaches:

wherein said exterior surface of said transition area has a transition takeout angle that is substantially greater than the substantially conical takeout angle of said forward section.

Takuma and DeBell teach that the angle of taper (5) or neck portion (20), respectively, is greater at some point than that of the tip. It would have been obvious to one of ordinary skill in the art at the time of the invention to use this design in order to keep the weight of the workpieces off the tip.

Regarding claim 19, the Takuma collective teaches:

wherein said exterior diameter of said bolt is in a range of 3 to 12 mm [Takuma teaches a bolt with a 11 mm diameter; paragraph 0007].

Regarding claims 20 and 21, the Takuma collective does not teach:

wherein said range is 3.5 to 10 mm or 4 to 8.5 mm.

However Takuma does teach that the diameter of the bolt is 11 mm as noted above.

It would have been obvious to one of ordinary skill in the art at the time of the invention that the size of the bolt would vary depending on the type and size of the materials involved, the manufacturing processes involved, and the end use of the

product made. Therefore, choosing a size of a bolt is not an inventive step but merely a basic step in manufacturing.

Additionally, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233.

Also, In re Geisler 43 USPQ2d 1365 (Fed. Cir. 1997); In re Woodruff, 16 USPQ2d 1934 (CCPA 1976); In re Malagari, 182 USPQ 549, 553 (CCPA 1974) and MPEP 2144.05.

Regarding claims 30 and 31, the Takuma collective teaches:

wherein said wear-resistant sintered materials comprise oxide ceramics or non-oxide ceramics and said ceramics include, Al₂O₃, ZrO₂, or Si₃N₄,, or mixtures thereof [the Takuma collective teaches using these materials as the ceramic bolt].

Regarding claims 32 and 33, the Takuma collective does not teach:

wherein said portion of the entire length of said bolt extends over less than 50% of said entire length or less than 30% of said entire length.

All of the references show different amounts of contacting area between the end of the tip and the recess of the bolt. It would have been obvious to one of ordinary skill in the art at the time of the invention that this area can vary and that a smaller area for joining would require less material and machining but that too little of a contacting area would lead to insufficient joining. Therefore, varying this contacting area is a matter of design and optimization and since it has been held that where the general conditions of

a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233.

Regarding claim 34, the Takuma collective teaches:

wherein said receiving element is configured for use in welding equipment.

Regarding claim 35, the Takuma collective teaches:

wherein said welding equipment includes a pressure welding tool.

Conclusion

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CARLOS GAMINO whose telephone number is (571) 270-5826. The examiner can normally be reached on Monday-Thursday, 8:30am-7:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jessica L. Ward can be reached on (571) 272-1223. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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CG

/Jessica L. Ward/ Supervisory Patent Examiner, Art Unit 1793